

P37034

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE OFFICE OF PETITIONS**

In re Patent Application of:
Cindy KOHANEK et al.

Application No.: 09/904,425

Confirmation No.: 1776

Filed: July 12, 2001

Art Unit: 2859

For: LINEARITY MEASURING APPARATUS FOR
WAFER ORIENTATION FLAT

Examiner: G. Bradley Bennett

Attorney Docket No.: P37034

REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 C.F.R. 1.137(B)

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This is a Request for Reconsideration of Petition Under 1.137(b) to revive the above-identified application which became unintentionally abandoned for failure to file a timely and proper reply to a notice of action by the United States Patent and Trademark Office.

Petitioner is submitting herewith an extension of time for three months to extend the period for response until November 25, 2009 accompanied by the appropriate fee. In this regard, the necessary input from diverse parties having first hand knowledge of the involved facts was diligently pursued in the preparation of this Request for Reconsideration, and required obtaining the extension of time permitted in the Decision in obtaining pertinent facts for the various declarations being submitted herewith.

A Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. 1.137(b) (hereinafter "Petition") was filed on February 2, 2009. This Petition was dismissed in the Decision on Petition (hereinafter "Decision") mailed from the PTO on June 25, 2009.

The Petition indicates that a grantable petition must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

The Decision indicates that with regard to item (3) additional information is required, and therefore additional information is being submitted herewith with respect to item (3) in the form of Declarations by persons having first hand knowledge of the facts associated with the abandonment of the application as well as the failure to become aware of the abandonment of the application until about December 12, 2008 despite the exercise of due care or diligence.

In particular, the following Declarations are being submitted with the present Request for Reconsideration:

- (1) Supplemental Declaration of Jules E. Goldberg, Esq. (hereinafter “Supplemental Goldberg Declaration”);
- (2) Supplemental Declaration of Ruth Montalvo (hereinafter “Supplemental Montalvo Declaration”);
- (3) Supplemental Declaration of Masayoshi Suda (hereinafter “Supplemental Suda Declaration”); and
- (4) Declaration of Nobuyuki Hayashi, Koki Masuda, Toshinobu Miura and Hiroyuki Hasegawa (hereinafter “Hayashi et al. Declaration”)¹.

These Declarations render it clear that:

- (1) The July 3, 2002 Office Action was reported by Mr. Goldberg at Reed Smith to Mr. Suda, at the Suda Patent Office, and from Mr. Suda to SUMCO IP Department; and that instructions were then relayed from the SUMCO IP Department through Mr. Suda to Mr. Goldberg to file a response to the Office Action - See, for example, Supplemental Goldberg Declaration paragraphs 7-10; Supplemental Suda Declaration paragraphs 9-20; and Hayashi et al. Declaration paragraph 11-13;

¹ The Declaration of Nobuyuki Hayashi, Koki Masuda, Toshinobu Miura and Hiroyuki Hasegawa is submitted as two separately executed Declarations

(2) A response to the Office Action was unintentionally not filed - See, for example, Supplemental Goldberg Declaration paragraphs 12-16; and Supplemental Montalvo Declaration paragraphs 11-15; Suda Supplemental Declaration paragraphs 25 and 26; and Hayashi et al. Declaration paragraph 17;

(3) A telephone call was apparently made by the Examiner to Mr. Goldberg regarding abandonment of the application during the week of February 3, 2003 - See, for example, Supplemental Goldberg Declaration paragraph 13;

(4) A Petition to Revive was apparently intended to be filed, appears on the face of the file, but is not present in the file and apparently has never been received by the Patent and Trademark Office - See, for example, Goldberg Supplemental Declaration paragraphs 12, 14 and 16; and Supplemental Montalvo Declaration paragraphs 11-13 and 15;

(5) Reference is made to a Notice of Abandonment in the docket system, but with reference to the Petition to Revive, and is not present in the file - See, for example, Goldberg Supplemental Declaration paragraphs 12-14 and 16; and Supplemental Montalvo Declaration paragraphs 11-13 and 15;

(6) Instructions being provided for filing the response to the U.S. counsel, Mr. Goldberg, no further input was required by either of the Suda Patent Office or the SUMCO IP Department who relied upon the expertise of their U.S. counsel upon providing instructions for filing a response, did not have procedures in place to check the status of U.S. applications, and presently have procedures for checking on U.S. filing dates - See, for example, Supplemental Suda Declaration paragraphs 3-6, 23 and 24; and Hayashi et al. Declaration paragraphs 16, 18 and 19;

(8) The Reed Smith docketing system showing the filing of the Petition for Revival apparently led to no further action being needed until receipt of a Decision on Petition – See, for example, Supplemental Goldberg Declaration paragraphs 14-16; and Supplemental Montalvo Declaration paragraphs 11-13 and 15; and

(9) The abandonment of the application and the failure to discover the abandonment of the application occurred despite the exercise of due care or diligence, including the use of a commercial docketing system, but arose due to the totality of circumstances associated with this application as referenced in the submitted Declarations including those submitted with the present Request for Reconsideration and the Petition.

Regarding the redacted information included in the correspondence noted in the Decision, the redacted information pertains to information for proceeding with prosecution of the application, including acceptance of the allowed claims and cancelation of the rejected claims. The redacted information does not refer to any intent to abandon the application, and does not include any information regarding any awareness of abandonment of the application. During an October 7, 2009 telephone call with Mr. Derek Woods of the Petitions Office at the Patent and Trademark Office the undersigned was advised that this explanation would appear to be acceptable in view of the fact that documents are being filed under declaration or with a registration number. However, Mr. Woods indicated that this issue could not be evaluated until submission of the Request for Reconsideration.

Petitioner has undertaken a detailed review of the events leading to the abandonment of the application as well as events following the abandonment of the application until the discovery of the abandonment. Following this detailed review, including obtaining

declarations from parties having first hand knowledge of the events, Petitioner once again submits that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional, and occurred despite the exercise of due care or diligence at least for the reasons set forth in the Declarations set forth in this Request for Reconsideration and the Declarations submitted with the Petition as filed on February 2, 2009. In this regard, for the sake of brevity, Petitioner is not repeating all of the information and facts as presented in the Petition, but incorporate by reference all of the information and facts, including each of the Declarations as submitted with the Petition, as if set forth in their entirety herein.

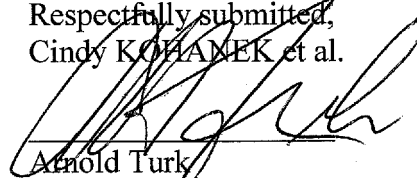
Accordingly, because the entire delay in filing the required Reply from the due date of the PTO Reply at issue, until the filing of the grantable Petition pursuant to 37 C.F.R. 1.137(b) was unintentional, the Petition should be granted, and the Reply should be processed.

If for any reason any additional information may be necessary for granting of the Petition, the Patent and Trademark Office is respectfully requested to contact the undersigned.

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Authorization is hereby provided to charge any fee necessary for entry of the Petition, this Request for Reconsideration, the Reply to the Office Action, any required extension of time and/or any fee necessary for maintaining the pendency of the application to Deposit Account No. 19-0089.

Respectfully submitted,
Cindy KOHANEK et al.



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November 2, 2009
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